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23599 7590 03/18/2010 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER EVANS, KIMBERLY L				
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3629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

Office Action Summary**Application No.**

10/661,508

Applicant(s)

CORDELLI, BRANDT GERARD

Examiner

KIMBERLY EVANS

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-20,33,34 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11-20,33,34,39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments

1. This office action in response to the amendments filed December 23, 2009.
2. Claims 1 and 2 have been amended. Claims 3, 4, 9, 10, 21-32, and 35-38 have been cancelled. Claims 43 and 44 are new.
3. Claims 1, 2, 5-8, 11-20, 33, 34, and 39-44 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - (a) Determining the scope and contents of the prior art.
 - (b) Ascertaining the differences between the prior art and the claims at issue.
 - (c) Resolving the level of ordinary skill in the pertinent art.
 - (d) Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 2, 5-8, 11, 12, 17, 18, 33, 34, 39, 40, 43, and 44 are rejected under 35 USC 103(a) as being unpatentable over Wahlbin et al., US Patent Publication No US 2002/0128881A1 in view of in view of DeTore et al., US Patent No 4,975,840.
7. With respect to Claims 1 and 2,
Wahlbin discloses the following limitations,
 - *a computer particularly configured with:*
 - *particular data setting forth a multiplicity of categories of circumstances relevant to analyzing the claim; which either apply or do not apply to the claim, and (see at least Figure 40 and Figure 55, paragraph 14: "...Effects on the liability due to factors specific to the vehicle, driver, and environment may be taken into account by identifying specific factors that may be relevant to the real accident.)*

- *computer-executable instructions particular for determining from the number of categories found to apply (see at least Figures 42 to 54, paragraph 294: "...a graphical user interface similar to that illustrated in FIGS. 42 to 54 may be combined with accident reconstruction methodology to assess the credibility of details in witness accident descriptions...")*
- *wherein the computer-executable instructions include programmed weightings of the applicable categories used for making the determination and (see at least paragraph 15: "...The contribution of the factors to the liability may also be adjusted. The adjustments may take into account sets of characteristics corresponding to the real accident and/or the preference of a claims organization. A situational weight (i.e., an adjustment related to the characteristics of a specific accident) may be based on knowledge obtained from experienced claims adjusters...")*
- *and a programmed threshold of the sum of weightings of the total categories or a sub-set of categories which determines the referral result,(see at least paragraph 147: "...the levels of the situational weights (e.g., N/A, low, normal, and high) may be represented as percent weights (e.g., 0%, 50%, 100%, and 150%, respectively)..."; paragraph 146: "...the insurance carrier may have determined that the base liability for the insured was 80%, with a lower bound of 50% and an upper bound of 100%. Consequently, base liability for the claimant may be 20%..."*)

Wahlbin does not distinctly disclose the following limitations, but DeTore however as shown discloses,

- *whether the claim should be referred to a higher review level* (see at least column 8, lines 48-54: "... When it has been established that additional underwriting is required (i.e., at least some problems remain unresolved after the initial screening step), and initial underwriting has occurred to further define the problems and to identify and request any additional information which may be required to resolve the problems, the case is assigned to an underwriter for resolution...")
- *computer-executable instructions for display of the results of applicable categories the result of the determination of whether a claim for a defense under a liability insurance policy should be referred to a higher review level* (see at least Figure 3, column 7, lines 3-5: "...After initial data collection, screening and entry, the system determines whether or not additional underwriting is required. This step is represented by block 42...."; lines 18-22: "... the information collected in the reporting step provides administrators and management with trend information which may be useful in strategic decision making..."; lines 31-38: "...Initial underwriting also determines if additional information is required to underwrite a particular case (decision block 48) and, if so, preferably generates requests for the additional information (block 50).

Such additional information and requirements may include (without limitation) medical examinations, test reports, financial statements, and public records (e.g., motor vehicle reports).)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the computerized method and system of adjusting liability estimates in an accident liability assessment program of Wahlbin and the method and apparatus for evaluating a potentially insurable risk of DeTore because it provides an efficient means for administrators and management to further define problems and identifying/requesting additional information for resolution.

8. With respect to Claims 5 and 6,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

- *computer-executable instructions for determining, from the number of categories found to apply (Figure 40),*
- *whether the claim should be automatically referred to a higher review level without further analysis or referred to a higher review level with qualification of an additional analysis. (see at least paragraph 99: "...Computer system 150 may be operable to execute the computer programs to implement assessment of liability in a motor vehicle accident by considering characteristics that describe such an accident combined with expert knowledge collected from experienced claims adjusters....")*

9. With respect to Claims 7 and 8,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

- *computer is further configured to display the results of applicable categories so that multiple categories are displayed in a primarily prominent portion of the display and other categories are displayed in a secondarily prominent portion, the determination of referral being made from the categories in both such portions.*(see at least Figure 9a, Figures 40-55..."paragraph 268: "...FIG. 40 is a screen shot of situational weight configuration window 4001 according to one embodiment. Situational weight configuration window 4001 may be used to configure situational weights associated with one or more factors for a given roadway configuration and accident type combination. The situational weights may be used to adjust the magnitude of the effect of the factors on liability, as described with reference to FIG. 9a..."")

10. With respect to Claims 11 and 12,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

- *wherein the primarily prominent portion contains five categories.*(see at least Figure 9a, paragraph 36: "...[0036] FIG. 9a includes tables illustrating a first

method of assessing the contribution of factors to the liability according to one embodiment; ...")

11. With respect to Claims 17 and 18,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

- *wherein at least one category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable.* (see at least Figures 9a and 40, paragraph 77: FIG. 40 is a screen shot of a window for editing the estimate effect of a factor according to one embodiment; ...")

12. With respect to Claims 33 and 34,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

- *wherein the computer includes at least one data entry for information identifying the claim.*(see at least paragraph 21: "...To assist the user in providing data regarding characteristics of the vehicle accident, the computer system may display graphical representations of the characteristics such as the roadway configurations, accident types, and impact points. The user may identify discords within the entered data....")

13. With respect to Claims 39 and 40,

Wahlbin and DeTore disclose all of the above limitations, Wahlbin further discloses,

which further includes computer-executable instructions for changing the programmed weightings applicable to each category based on the previous data indicating that particular categories deserve more or less weight in making the determination.(see at least Figure 9a, paragraph 145: "...the effect of a factor on the liability may be adjusted by a situational weight for each roadway configuration/accident type and vehicle. A situational weight may have four levels: N/A (factor not applicable), low, normal, and high. An experienced claims adjuster may determine an appropriate situational weight to apply...").

14. With respect to Claims 43 and 44,

Wahlbin and DeTore discloses the following limitations, DeTore further discloses,

- *a determination of whether: the claim either in full or in part is plainly not covered by the policy, the claim either in full or in part is potentially covered and therefore obligates the insurer to defend but not indemnify the policyholder, or the claim either in full or in part is plainly covered by the policy and thus obligates the insurer to both defend the policyholder and pay any settlement or judgment, and* (see at least Figures 3-7, column 6, lines 59- 63: "...As noted initial screening of the information preferably takes place concurrently with information collection. Initial screening allows for decisions

to be made regarding a certain percentage of the incoming cases. ... (i.e., by issuing or declining to issue coverage) on the basis of the initial screening process.)

- *optionally, also includes a determination of whether the above determinations can be made by the claims handling personnel with or without management review.*(see at least Figure 3, column 7, lines 24-26: "...If the system determines that more underwriting is required for a particular case, the program proceeds to the initial underwriting step..."; column 8, lines 48-55: '...When it has been established that additional underwriting is required (i.e., at least some problems remain unresolved after the initial screening step), and initial underwriting has occurred to further define the problems and to identify and request any additional information which may be required to resolve the problems, the case is assigned to an underwriter for resolution. This step is represented by block 52 in FIG. 3...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the computerized method and system of adjusting liability estimates in an accident liability assessment program of Wahlbin and the method and apparatus for evaluating a potentially insurable risk of DeTore because it provides an efficient means for automatically screening insurance information and/or determining if more underwriting is required by administrators and management to further define problems and identifying/requesting additional information for resolution.

15. Claims 13-16, 19, 20, 41, and 42 are rejected under 35 USC 103(a) as being unpatentable over Wahlbin in view of DeTore, in further view of Jernberg US Patent No US 6,336,096 B1.
16. With respect to Claims 13 -16,
- Wahlbin and DeTore disclose all of the above limitations, the combination of Wahlbin and DeTore, does not distinctly disclose the following limitations, but Jernberg however as shown discloses,
- *wherein the five categories in the primarily prominent portion are: 1) Preliminary Analysis Suggests Denial; 2) Mixed Suit - Covered and/or Potentially Covered with Uncovered Claims; 3) Key Policyholder Counsel Tenders Claim for Defense or Independent/Claims Counsel Involved; 4) Misrepresentation or Omission in Application and/or Pre-existing Loss Suspected; and one of the following: 5) Umbrella/Excess Coverage by Company, 6) Defense Tendered by Other than Named Insured, 7) Latent and/or Continuous and Progressive Injury or Damage, 8) Other Carriers Involved, or 9) Target Claims/Damages Alleged*
 - *wherein the secondarily prominent portion contains the other categories 5) to 9) not on the primarily prominent portion plus the following categories: 10) Internet-Related Liability Issues, 11) Potential Personal Injury or Advertising*

Injury, 12) Insolvent Insurer and/or Guaranty Fund Involved or On Notice, 13) SIR of \$100,000 or More, and 14) Employment-Related Claims.

(see at least Figures 1-3A-3C, column 2, lines 59-61: "...a method to evaluate the proportionate share of the aggregate premium contribution for each of the multiple PRPs to be covered..."; column 3, lines 33-40: "...A qualitative decision pertaining to the anticipated liability, or case settlement value, is proposed to the parties. State adjustment factors are provided by an independent third party and are used to adjust the insurer's and PRP's relative shares of liability. An allocation theory or algorithm is applied to determine relative contributions between and among various insurers and the PRP/policyholder..."; column 5, lines 25-40: "...Input data pertaining to the PRPs is stored in PRP database 24. Example elements to be stored in database 24 are shown in Insured Field identifier list 62 and Policy Field identifier list 72. Input data pertaining to insurers is stored in Insurer's database 26. Example elements to be stored in database 26 are shown in Insurer Field identifier lists 64 and 66. Settlement data, confidential offers of settlement from both PRPs and Insurers, is stored in Settlement database 30. Example elements to be stored in database 30 are shown in InsurerSiteSettleOffer Field identifier list 78 and PRPSiteSettleDemand Field identifier list 80.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the computerized method and system of adjusting liability estimates in an accident liability assessment program of Wahlbin with the method

and apparatus for evaluating a potentially insurable risk of DeTore and the system and method for evaluating liability of Jernberg because it provides an efficient means for evaluating, facilitating analysis and manipulation of data to determine liability among insurers. Furthermore, Claims 13-16 refer to non-functional descriptive material, "categories" and thus is not given patentable weight because applicant fails to disclose the steps involved in using the features above. Claims 13-16 recite a mere arrangement of data (categories) on the computer display.

17. With respect to Claims 19 and 20,

Wahlbin, DeTore, and Jernberg disclose all of the above limitations, Wahlbin further discloses,

- *wherein each category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable. (see at least Figure 38, paragraph 75: "...FIG. 38 is a screen shot of a window from a Knowledge Acquisition utility or tuning utility for selecting a roadway configuration/accident type combination according to one embodiment;...")*

18. With respect to Claims 41 and 42,

Wahlbin, DeTore, and Jernberg disclose all of the above limitations, Wahlbin further discloses,

- *wherein the programmed weightings for the categories in the primarily prominent portion are higher than the programmed weightings for the categories in the secondarily prominent portion.*(see at least Figure 8b, 9a, 10a-36, paragraph 145: "...A situational weight may have four levels: N/A (factor not applicable), low, normal, and high...."; paragraph 146: "...the insurance carrier may have determined that the base liability for the insured was 80%, with a lower bound of 50% and an upper bound of 100%. Consequently, base liability for the claimant may be 20%..."; paragraph 148: "...In other embodiments, the penalty, and/or situational weight may not be determined directly by a user. ... the penalty and/or situational weight may be determined from the answers to a series of questions. ...FIGS. 10a to 36 are flowcharts that depict methods of determining penalties values associated with various factors. In the FIGS. 10a to 36, the penalty values may be represented in certain of the flowchart terminuses as percentage values. In certain flowcharts, the penalty values may be represented by the terms "low," "medium," or "high.")

Response to Arguments

19. Applicant's arguments received on April 3, 2009 have been fully considered but they are moot in view of the new ground(s) of rejection. The new grounds of rejection are necessitated by Applicant's amendments and addition of new claims.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are

unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629

